

REMARKS

Claims 1-6 were canceled by preliminary amendment. Claims 7-28 are pending in the application.

The examiner has maintained the rejection of claims 11-14 and claim 26 under 35 USC §112, second paragraph. However applicants have amended these claims in order to meet the formal requirements of 35 USC §112.

Furthermore, the examiner has rejected claims 7-24 under 35 USC §112, first paragraph. The examiner argues that the limitation of "excluding carbon catalysts" was not present in the original claims as filed. Applicants assert that this limitation is supported in the specification on page 4, lines 1-6 which describes the catalyst as "comprising at least one silicate" and the three-letter codes on page 5, lines 5-27. The standard for meeting the written description requirement is described as, "The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). MPEP §2163.02.

According to the MPEP, "While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." MPEP §2163 (B). Accordingly, applicants have met this requirement through the explicit description of the catalyst as cited above and also through the discussion of Felthouse (US 4,582,650) in the specification on page 1, lines

25-35: One of ordinary skill in the art would recognize that the description of the catalyst in light of the reference would exclude the carbon catalyst. Therefore, applicants respectfully request the rejection be withdrawn.

Additionally, the examiner rejects claims 11-14 and 26 under 35 USC §112, first paragraph for reciting the limitation of "having framework type codes." This limitation is supported in the specification at page 5, lines 7-17 which recites the three letter codes for the zeolite structures. As cited above, the written description requirement is not an *in haec verba* requirement and thus this language is inherently disclosed in the applicants specification at filing.

The examiner has also rejected claims 7-24 under 35 USC §112, second paragraph, as indefinite. The examiner argues that the limitation "excluding carbon catalysts" makes the claim unclear as to the metes and bounds of the invention. The test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification. *Bausch & Lomb Inc. v. Alcon Labs. Inc.*, (DCWDNY 1999) 64 F Supp.2d 233, 52 USPQ2d 1385 citing *Amgen Inc. v. Chugai Pharm. Co.* (Fed. Cir 1991) 927 F.2d 1200, 18 USPQ2d 1016, 1030. In this instance applicant's specification includes a discussion of the Felthouse reference which comprises an activated carbon. Accordingly, this limitation is based on the exclusion of this type of activated carbon catalyst which is discussed in the application at page 1, lines 25-35 and is therefore incorporated by reference.

The examiner has also rejected claims 25-27 and claims 25-28 under 35 USC §102 and 103, respectively. However, these same rejections were given and then

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withdrawn to claims 7-24 in light of the addition of a limitation. Accordingly, applicants have amended claims 25-28 in this manner and respectfully request the rejection be withdrawn in light of the arguments above that this limitation is not new matter.

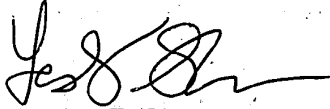
In view of the foregoing amendments and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

**Please find attached a check for \$420.00 for a two month extension of time.**

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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**COMPLETE LISTING OF CLAIMS IN THE APPLICATION**

1-6 (canceled)

7. (previously presented) A process for preparing N-phosphonomethylglycine or a salt thereof by bringing phosphonomethyliminodiacetic acid or a salt thereof into contact with at least one oxygen-containing oxidant in the presence of a heterogeneous catalyst comprising at least one silicate, excluding carbon catalysts.

8. (previously presented) A process as claimed in claim 7, wherein the oxygen-containing oxidant or oxidants is/are selected from the group consisting of hydroperoxides, gases containing molecular oxygen, oxygen-donating compounds, nitrogen oxides and mixtures of two or more thereof.

9. (previously presented) A process as claimed in claim 7, wherein the silicate or silicates is/are selected from the group consisting of zeolites, sheet silicates, naturally occurring or synthetically produced clay minerals, clathrasils and mixtures of two or more thereof.

10. (previously presented) A process as claimed in claim 8, wherein the silicate or silicates is/are selected from the group consisting of zeolites, sheet silicates, naturally occurring or synthetically produced clay minerals, clathrasils and mixtures of two or more thereof.

11. (Currently amended) A process as claimed in claim 7, wherein the crystalline silicate or silicates is/are selected from the group consisting of zeolite structure-types having framework type codes ABW, ACO, AEI, AEL, AEN, AET, AFG, AFI,

AFN, AFO, AFR, AFS, AFT, AFX, AFY, AHT, ANA, APC, APD, AST, ATN, ATO, ATS, ATT, ATV, AWO, AWW, BEA, BIK, BOG, BPH, BRE, CAN, CAS, CFI, CGF, CGS, CHA, CHI, CLO, CON, CZP, DAC, DDR, DFO, DFT, DOH, DON, EAB, EDI, EMT, EPI, ERI, ESV, EUO, FAU, FER, GIS, GME, GOO, HEU, IFR, ISV, ITE, JBW, KFI, LAU, LEV, LIO, LOS, LOV, LTA, LTL, LTN, MAZ, ~~MCM-22~~, MEI, MEL, MEP, MER, MFI, MFS, MON, MOR, MSO, MTF, MTN, MTT, MTW, MWW, NAT, NES, NON, OFF, OSI PAR, PAU, PHI, RHO, RON, RSN, TRE, TH, RUT, SAO, SAT, SBE, SBS, SBT, SFF, SGT, SOD, STF, STI, STT, TER, THO, TON, TSC, VET, VFI, VNI, VSV, WEI, WEN, YUG, ZON AND ~~ITQ-4~~ and mixtures of two or more thereof.

12. (Currently amended) A process as claimed in claim 8, wherein the crystalline dilicate or silicates is/are selected from the group consisting of zeolite-structure types having framework type codes ABW, ACO, AEI, AEL, AEN, AET, AFG, AFI, AFN, AFO, AFR, AFS, AFT, AFX, AFY, AHT, ANA, APC, APD, AST, ATN, ATO, ATS, ATT, ATV, AWO, AWW, BEA, BIK, BOG, BPH, BRE, CAN, CAS, CFI, CGF, CGS, CHA, CHI, CLO, CON, CZP, DAC, DDR, DFO, DFT, DOH, DON, EAB, EDI, EMT, EPI, ERI, ESV, EUO, FAU, FER, GIS, GME, GOO, HEU, IFR, ISV, ITE, JBW, KFI, LAU, LEV, LIO, LOS, LOV, LTA, LTL, LTN, MAZ, ~~MCM-22~~, MEI, MEL, MEP, MER, MFI, MFS, MON, MOR, MSO, MTF, MTN, MTT, MTW, MWW, NAT, NES, NON, OFF, OSI PAR, PAU, PHI, RHO, RON, RSN, TRE, TH, RUT, SAO, SAT, SBE, SBS, SBT, SFF, SGT, SOD, STF, STI, STT, TER, THO, TON, TSC, VET, VFI, VNI, VSV, WEI, WEN, YUG, ZON AND ~~ITQ-4~~ and

mixtures of two or more thereof.

13. (Currently amended) A process as claimed in claim 9, wherein the crystalline dilicate or silicates is/are selected from the group consisting of zeolite-structure types having framework type codes ABW, ACO, AEI, AEL, AEN, AET, AFG, AFI, AFN, AFO, AFR, AFS, AFT, AFX, AFY, AHT, ANA, APC, APD, AST, ATN, ATO, ATS, ATT, ATV, AWO, AWW, BEA, BIK, BOG, BPH, BRE, CAN, CAS, CFI, CGF, CGS, CHA, CHI, CLO, CON, CZP, DAC, DDR, DFO, DFT, DOH, DON, EAB, EDI, EMT, EPI, ERI, ESV, EUO, FAU, FER, GIS, GME, GOO, HEU, IFR, ISV, ITE, JBW, KFI, LAU, LEV, LIO, LOS, LOV, LTA, LTL, LTN, MAZ, ~~MCM-22~~, MEI, MEL, MEP, MER, MFI, MFS, MON, MOR, MSO, MTF, MTN, MTT, MTW, MWW, NAT, NES, NON, OFF, OSI PAR, PAU, PHI, RHO, RON, RSN, TRE, TH, RUT, SAO, SAT, SBE, SBS, SBT, SFF, SGT, SOD, STF, STI, STT, TER, THO, TON, TSC, VET, VFI, VNI, VSV, WEI, WEN, YUG, ZON AND ~~ITQ-4~~ and mixtures of two or more thereof.

14. (Currently amended) A process as claimed in claim 10, wherein the crystalline dilicate or silicates is/are selected from the group consisting of zeolite-structure types having framework type codes ABW, ACO, AEI, AEL, AEN, AET, AFG, AFI, AFN, AFO, AFR, AFS, AFT, AFX, AFY, AHT, ANA, APC, APD, AST, ATN, ATO, ATS, ATT, ATV, AWO, AWW, BEA, BIK, BOG, BPH, BRE, CAN, CAS, CFI, CGF, CGS, CHA, CHI, CLO, CON, CZP, DAC, DDR, DFO, DFT, DOH, DON, EAB, EDI, EMT, EPI, ERI, ESV, EUO, FAU, FER, GIS, GME, GOO, HEU, IFR, ISV, ITE, JBW, KFI, LAU, LEV, LIO, LOS, LOV, LTA, LTL, LTN, MAZ, ~~MCM-22~~,

MEI, MEL, MEP, MER, MFI, MFS, MON, MOR, MSO, MTF, MTN, MTT, MTW, MWW, NAT, NES, NON, OFF, OSI PAR, PAU, PHI, RHO, RON, RSN, TRE, TH, RUT, SAO, SAT, SBE, SBS, SBT, SFF, SGT, SOD, STF, STI, STT, TER, THO, TON, TSC, VET, VFI, VNI, VSV, WEI, WEN, YUG, ZON AND ~~HTQ-4~~ and mixtures of two or more thereof.

15. (previously presented) A process as claimed in claim 7, wherein the at least one heterogeneous catalyst further comprises at least one element selected from among the elements of groups Ia, IIa, IIIa, IVa, Va, VIa, VIIa, VIIIa, Ib, IIb, IIIb, IVb, Vb, VIb, VIIb of the Periodic Table.

16. (previously presented) A process as claimed in claim 8, wherein the at least one heterogeneous catalyst further comprises at least one element selected from among the elements of groups Ia, IIa, IIIa, IVa, Va, VIa, VIIa, VIIIa, Ib, IIb, IIIb, IVb, Vb, VIb, VIIb of the Periodic Table.

17. (previously presented) A process as claimed in claim 9, wherein the at least one heterogeneous catalyst further comprises at least one element selected from among the elements of groups Ia, IIa, IIIa, IVa, Va, VIa, VIIa, VIIIa, Ib, IIb, IIIb, IVb, Vb, VIb, VIIb of the Periodic Table.

18. (previously presented) A process as claimed in claim 10, wherein the at least one heterogeneous catalyst further comprises at least one element selected from among the elements of groups Ia, IIa, IIIa, IVa, Va, VIa, VIIa, VIIIa, Ib, IIb, IIIb, IVb, Vb, VIb, VIIb of the Periodic Table.

19. (previously presented) A process as claimed in claim 11, wherein the at least one

heterogeneous catalyst further comprises at least one element selected from among the elements of groups Ia, IIa, IIIa, IVa, Va, VIa, VIIa, VIIIa, Ib, IIb, IIIb, IVb, Vb, VIb, VIIb of the Periodic Table.

20. (previously presented) A process as claimed in claim 7, wherein the heterogeneous catalyst is regenerated after complete or partial loss of activity and the regenerated heterogeneous catalyst is reused for preparing N-phosphonomethylglycine or a salt thereof from phosphonomethyliminodiacetic acid or a salt thereof.
21. (previously presented) A process as claimed in claim 8, wherein the heterogeneous catalyst is regenerated after complete or partial loss of activity and the regenerated heterogeneous catalyst is reused for preparing N-phosphonomethylglycine or a salt thereof from phosphonomethyliminodiacetic acid or a salt thereof.
22. (previously presented) A process as claimed in claim 9, wherein the heterogeneous catalyst is regenerated after complete or partial loss of activity and the regenerated heterogeneous catalyst is reused for preparing N-phosphonomethylglycine or a salt thereof from phosphonomethyliminodiacetic acid or a salt thereof.
23. (previously presented) A process as claimed in claim 10, wherein the heterogeneous catalyst is regenerated after complete or partial loss of activity and the regenerated heterogeneous catalyst is reused for preparing N-phosphonomethylglycine or a salt thereof from phosphonomethyliminodiacetic



acid or a salt thereof.

24. (previously presented) A process as claimed in claim 11, wherein the heterogeneous catalyst is regenerated after complete or partial loss of activity and the regenerated heterogeneous catalyst is reused for preparing N-phosphonomethylglycine or a salt thereof from phosphonomethyliminodiacetic acid or a salt thereof.
25. (Currently amended) A process for preparing N-phosphonomethylglycine or a salt thereof by bringing phosphonomethyliminodiacetic acid or a salt thereof into contact with at least one oxygen-containing oxidant selected from a group consisting of hydroperoxides, gases containing molecular oxygen, oxygen-donating compounds, nitrogen oxides and mixtures of two or more thereof; in the presence of a heterogeneous catalyst, excluding carbon catalysts, comprising at least one silicate selected from the group consisting of zeolites, sheet silicates, naturally occurring or synthetically produced clay minerals, clathrasils and mixtures of two or more thereof.
26. (Currently amended) A process as claimed in claim 25, wherein the zeolites are selected from the group consisting of zeolites of the structure types having framework type codes ABW, ACO, AEI, AEL, AEN, AET, AFG, AFI, AFN, AFO, AFR, AFS, AFT, AFX, AFY, AHT, ANA, APC, APD, AST, ATN, ATO, ATS, ATT, ATV, AWO, AWW, BEA, BIK, BOG, BPH, BRE, CAN, CAS, CFI, CGF, CGS, CHA, CHI, CLO, CON, CZP, DAC, DDR, DFO, DFT, DOH, DON, EAB, EDI, EMT, EPI, ERI, ESV, EUO, FAU, FER, GIS, GME, GOO, HEU, IFR, ISV, ITE,

JBW, KFI, LAU, LEV, LIO, LOS, LOV, LTA, LTL, LTN, MAZ, ~~MCM-22~~, MEI, MEL, MEP, MER, MFI, MFS, MON, MOR, MSO, MTF, MTN, MTT, MTW, MWW, NAT, NES, NON, OFF, OSI PAR, PAU, PHI, RHO, RON, RSN, TRE, TH, RUT, SAO, SAT, SBE, SBS, SBT, SFF, SGT, SOD, STF, STI, STT, TER, THO, TON, TSC, VET, VFI, VNI, VSV, WEI, WEN, YUG, ZON AND ~~ITQ-4~~ and mixtures of two or more thereof.

27. (Previously presented) A process as claimed in claim 25 wherein the at least one heterogeneous catalyst further comprises at least one element selected from among the elements of groups Ia, IIa, IIIa, IVa, Va, VIa, VIIa, VIIIa, Ib, IIb, IIIb, IVb, Vb, Vab, VIIb of the Periodic Table.

28. (previously presented) A process as claimed in claim 25, wherein the heterogeneous catalyst is regenerated after complete or partial loss of activity and the regenerated heterogeneous catalyst is reused for preparing N-phosphonomethylglycine or a salt thereof from phosphonomethyliminodiacetic acid or a salt thereof.